THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARC A. FORTIN and MURRAY D. HUNTER

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Appeal No. 1999-2086
Application 08/692,062

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HEARD: April 19, 2000

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Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge, and PATE, Administrative Patent Judge.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 4 through 6, 34, 35, 37 through 39 and 41. With regard to the other pending claims, claims 13

through 18 and 42 through 48 have been allowed, claims 3, 7 through 12, 36 and 40 are considered to be allowable subject to being rewritten in independent form and claims 19 through 33 have been withdrawn from consideration as being directed to a non-elected invention.

The invention disclosed in the subject application relates to a work bench having a pair of spaced apart vise screws 30 for imparting relative movement to a pair of members 24, 26 on a table top to clamp a workpiece between the members. A first one of the screws is directly connected to a handle 110 by a pin 124. The second one of the screws is connected by a clutch 70 to handle 110. The clutch is defined by a sprocket 50 having detents 60. A pin 62 carried by the first screw is engagable in the detents 60 to engage the clutch so that both screws are rotated upon turning the handle 110. However, when a torque of predetermined magnitude is applied by the operator to handle 110, pin 62 disengages from detents 60 to disengage the clutch and thereby interrupt rotation of the second screw. Disengagement of clutch 70 enables rotation of the first screw with respect to (i.e., relative to) the second screw as defined in independent claims 1 and 6.

A copy of the appealed claims is appended to appellants' brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Coope et al (Coope)	4,046,364	Sep. 6, 1977
Stiltz et al (Stiltz)	4,265,435	May 5, 1981
Lee et al (Lee)	5,284,331	Feb. 8, 1994

Claims 1, 2, 4, 5, 34, 35, 37 through 39 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stiltz in view of Coope, and claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Stiltz in view of Coope and Lee.

According to the examiner's findings, Stiltz' work bench has pair of hand driven vise screws (see Figures 7 and 8), but lacks a clutch as recited in independent claims 1 and 6. For this feature, the examiner relies on the Coope patent and concludes that the teachings of Coope would have made it obvious to provide Stiltz' vise with a torque responsive clutch. The examiner's position is untenable.

In the first place, appealed claims 1 and 6 do not broadly call for a clutch connected in any manner to one or more vise screws to limit the torque applied thereto as the examiner seems to suggest on page 3 of the answer. Instead, claims 1 and 6 are specifically limited to a clutch that enables "rotation of one screw with respect to the other screw." Such a relationship is not taught by Coope.

Instead, Coope merely teaches the concept of connecting a torque-limiting clutch to a single vise screw to limit the torque applied to that screw. Thus, Coope lacks a suggestion of locating the clutch in Stiltz' dual screw arrangement to enable rotation of one screw with

respect to the other screw. This being the case, we cannot agree that the examiner has made out a prima facie case of obviousness with respect to claims 1, 2, 4, 5 and 41. Likewise, the examiner has not made out a prima facie case of obviousness with

respect to claim 6, inasmuch as the Lee patent does not rectify the shortcomings of Stiltz and Coope. Accordingly, we must reverse the § 103 rejections of claims 1, 2, 4 through 6 and 41.

Unlike claims 1 and 6, claim 34 contains certain limitations which are vague and indefinite as discussed infra. As a result, we are unable to apply the prior art to claim 34 without resorting to speculation and conjecture as to what appellants intended to claim as their invention. Accordingly, we are constrained to reverse the § 103 rejection of claims 34, 35 and 37 through 39 in light of the holdings in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1384, 165 USPQ 494, 496 (CCPA 1970). It should be understood that our reversal of the § 103 rejection of claims 34, 35 and 37 through 39 is not a reversal on the merits of the art rejection, but instead is a procedural reversal predicated upon the indefiniteness of the language in claim 34.

Under the provisions of 37 CFR § 1.196(b), the following new ground of rejection is entered against claims 34 through 40:[1]

[1] Although claims 36 and 40 were not involved in the instant appeal, they are nevertheless subject to rejection under 37 CFR § 1.196(b) (amended effective Dec. 1, 1997).

Claims 34 through 40 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite and inaccurate, thus failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Our first difficulty with the language in claim 34 centers on the recitation that the clutch enables "rotation of the other screw with respect to the screw which is being rotated" (emphasis added). According to claim 34, the screw "being rotated" appears to be readable on the screw that is directly connected to the handle rather than the screw that is connected through the clutch to the handle. Thus, the "other screw" in the last clause of claim 34 would be readable on the screw that is connected through the clutch to the handle. It is not clear how the clutch will enable the "other screw" (i.e., the screw that is connected through the clutch to the handle) to rotate with respect to (i.e., relative to) the screw "which is being rotated," presumably by turning the handle. At best, this clause is misdescriptive inasmuch as the disengagement of the clutch will interrupt rotation of the "other screw" to prevent rotation of the "other screw" with respect to the screw "being rotated."

With further regard to the last clause in claim 34, it is not clear what is meant by the recitation that the clutch is "coupled with" one of the screws. At best it would appear that the

term "coupled" is misdescriptive.

For the foregoing reasons claim 34 does not define the metes and bounds of the invention with a reasonable degree of precision as required in In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Dependent claims 35 through 40 are subject to the same criticism since they incorporate the subject matter of claim 34.

The examiner's decision rejecting the appealed claims is reversed, and a new ground of rejection has been entered against claims 34 through 40 pursuant to the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with

respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED 37 CFR 1.196(b)

IAN A. CALVERT)
Administrative Patent Judge)

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HARRISON E. McCANDLISH	)
Senior Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
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